

REMARKS

In the Office Action, the Examiner rejected claim 10 under 35 USC §112, second paragraph, and rejected claims 1-20 under 35 USC §103(a). These rejections are fully traversed below.

Claims 1, 9 and 15 have been amended to further clarify the subject matter regarded as the invention. Claims 10 and 16 have been cancelled without prejudice or disclaimer. The cancellation of claim 10 renders the rejection under the second paragraph of 35 USC §112 moot.

Claims 1-9, 11-15 and 17-20 remain pending in the application. Entry of this Amendment and reconsideration of the application are respectfully requested based on the following remarks.

PATENTABILITY OF CLAIMS

In the Office Action, the Examiner rejected claims 1-8 under 35 U.S.C. § 103(a) as unpatentable over Swab et al., U.S. Patent No. 6,929,365, in view of Jesiek, U.S. Patent No. 6,010,216; and further in view of Rydbeck, U.S. Patent No. 5,590,417; rejected claims 9-12 and 15-18 under 35 U.S.C. § 103(a) as unpatentable over Swab et al. in view of Jesiek and further in view of Horiguchi, U.S. Patent No. 7,031,667; rejected claims 13 and 14 under 35 U.S.C. § 103(a) as unpatentable over Swab et al. in view of Jesiek and further in view of Spitzer, U.S. Patent No. 6,091,546; and rejected claims 19 and 20 under 35 U.S.C. § 103(a) as unpatentable over Swab et al. in view of Jesiek and Horiguchi and further in view of Spitzer. These rejections are fully traversed below.

Claim 1 pertains to a pair of eyeglasses that include wireless communication capabilities. Among other things, claim 1 recites a “balancing weight provided within the internal area of at least one of said arms” (claim 1, lines 13-14). On pages 4 and 8 of the Office Action, the Examiner referenced

col. 5, lines 36-41 of Swab et al. Moreover, claim 1 also recites: “wherein said at least one battery is provided internal to a first of said arms, wherein said balancing weight is provided internal to a second of said arms so that the two arms are of substantially the same weight” (claim 1, lines 17-20).

While col. 5, lines 36-41 of Swab et al. does briefly mention that a battery and circuitry can be on opposing sides (temples) to balance the weight and volume, there is no teaching or suggestion in Swab et al. for one skilled in the art to add an extra weight to one temple for the express purpose of balancing the frames. If anything, Swab et al. teaches that balancing can be sought by placing components (i.e., battery and circuitry) on opposing sides, not by adding additional weight. Indeed, the norm of the glasses industry is believed to be to minimize the weight of glasses. Hence, adding extra weight to eyeglasses goes against the normal trend in the glasses industry.

Jesiek is also silent on adding weight to any part of a frame for a pair of eyeglasses. Jesiek teaches that the frame material removed equals the weight of the added circuitry. Thus, Jesiek is concerned with removing material to reduce weight, not adding material to increase weight. Hence, both Jesiek and Swab et al. fail to teach or suggest that extra weight would be added to a second arm to balance out the weight from the one or more electrical components provided internal to the first arm. Rydbeck was not asserted as being capable of teaching or suggesting such limitations discussed above.

Moreover, as another limitation, claim 1 recites “at least one speaker coupled to said wireless communication circuitry, at least a portion of said speaker being provided within the internal area of at least one of said two arms” (claim 1, lines 6-8). On page 3 of the Office Action, the Examiner relies on speaker 56 in Fig. 3 of Swab et al. as teaching a speaker. However, Fig. 3, if anything, only shows the speaker 56 as a separate element, not within a temple 19 or the frame 34.

Claim 15 pertains to a pair of eyeglasses that includes a frame having a pair of arms, with wireless communication circuitry being provided within the

internal area of one or both of the arms. In rejecting claim 15, the Examiner relies on a combination of Swab et al. in view of Jesiek and Horiguchi. Among other things, claim 15 recites “at least one operation indicator configured to indicate an operation of the wireless communication circuitry....” On page 6 of the Office Action, the Examiner admits that Swab et al. does not disclose such an operation indicator. In view of this deficiency, the Examiner combines Horiguchi with Swab et al. and Jesiek in order to reject claim 15.

Applicants disagree that the use of Horiguchi in any way overcomes the deficiencies of Swab et al. and Jesiek. Horiguchi pertains to a portable telephone, not a pair of eyeglasses. Given the distinct nature of these products, there would be no motivation for one skilled in the art to combine the portable telephone of Horiguchi with the eyeglasses of Swab et al. and Jesiek. Further, even if Horiguchi is somehow combinable with Swab et al. and Jesiek, the noncommunicative mode indicating lamp 1 of Horiguchi illuminates when the portable telephone is functioning in a noncommunicative mode (i.e., not communicating). Indeed, the expressed objective of Horiguchi is to notify persons around a user [of the portable telephone] that [the] portable telephone is functioning in the noncommunicative mode. Horiguchi, col. 3, lines 23-27. In contrast, the operation indicator as recited in claim 15 indicates operation of the wireless communication circuitry provided within the frame of the eyeglasses. This, if anything, the noncommunicative mode indicating lamp 1 of Horiguchi teaches away from indicating operation of wireless communication circuitry as recited in claim 15. Moreover, the operation indicator recited in claim 15 is part of an eyeglass frame, not a conventional portable telephone as in Horiguchi. In particular, claim 15 recites “wherein said at least one operation indicator is at least partially internal to said frame.” The noncommunicative mode indicating lamp 1 of Horiguchi is not taught or suggested as being anyway useful or applicable on a pair of eyeglasses, let alone at least partially internal to a frame for eyeglasses as recited in claim 15. Thus, Horiguchi fails to overcome the deficiencies of Swab et al. and Jesiek.

Regarding claims 13, 14, 19 and 20, irrespective of the Office Action's rationale in rejecting the claims, since Swab et al. in view of Jesiek, Rydbeck and Horiguchi do not teach or suggest any of the independent claims, bringing in Spitzer for additional features in the dependent claims 13, 14, 19 and 20 would not remedy deficiencies in the above four references regarding the independent claims.

Accordingly, it is submitted that claims 1 and 15 are patentably distinct from any combination of Swab et al. in view of Jesiek, Rydbeck, Horiguchi and/or Spitzer. Additional limitations recited in the independent claim are not further discussed as the above-discussed limitations are clearly sufficient to distinguish the claimed invention from Swab et al. in view of Jesiek, Rydbeck, Horiguchi and/or Spitzer. For example, claim 12 depends from claim 1 but are further patentably distinct from Swab et al., Jesiek, Horiguchi and Spitzer due to the operation indicator limitations recited therein.

Thus, it is respectfully requested that the Examiner withdraw the rejections under 35 USC § 103(a).

SUMMARY

It is submitted that (i) the rejection under 35 USC § 112(2) is moot and (ii) the rejections under 35 USC § 103(a) have been traversed. Reconsideration of the application and an early Notice of Allowance are earnestly solicited.

If there are any issues remaining which the Examiner believes could be resolved through either a Supplemental Response or an Examiner's Amendment, the Examiner is respectfully requested to contact the undersigned representative at the telephone number listed below.

Applicants hereby petition for an extension of time which may be required to maintain the pendency of this case, and any required fee for such extension or

any further fee required in connection with the filing of this Amendment is to be charged to Deposit Account No. 50-3894.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'C. Douglass Thomas', written over the printed name.

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